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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/982,348	10/18/2001	Edward J. McGunn	272.00009	6707

7590

06/20/2003

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EXAMINER

BANGACHON, WILLIAM L

ART UNIT

PAPER NUMBER

2635

DATE MAILED: 06/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/982,348

Applicant(s)

MCGUNN ET AL.

Examiner

William Bangachon

Art Unit

2635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☒ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10/18/01 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 6) ☐ Other: _____.

DETAILED ACTION

Examiner's Response

1. In response to the application filed 18 October 2001, the application has been examined. The Examiner has considered the presentation of claims in view of the disclosure and the present state of the prior art. It is the Examiner's position that claims 1-34 are unpatentable for the reasons set forth in this Office action:

Information Disclosure Statement

2. It is noted that there is no PTO 1449 submitted with this application.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the secret location on a computer screen or what is displayed on a computer screen or how the secret location on a computer screen is displayed as recited in claims 11-12 and 23-24, the step of encrypting said PIN or an encryptor in claims 4, 15, and 32, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Claims 11-12 and 22-23 lacks antecedent basis in the specification.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

6. Claims 11-12 and 23-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 11 and 12, it is unclear and confusing whether the computer screen displays a secret location on a predetermined location on the computer screen or whether the secret location on the computer screen displays a predetermined location.

In claims 23 and 24, it is unclear and confusing on whether the open door option displays a secret location on a computer display or whether the secret location on a computer displays an open door option.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 2635

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 1-3, 6-9, 13-14, 18-21, 25-31, and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,815,557 (Larson).

In claims 1, 6, and 27-28, Larson teach of a method of controlling a real estate lockbox (12) (analogous to the claimed safe) {see whole document}, said method comprising the steps of:

providing an electronic lock (12, 12', 56, 64) for said lockbox/safe {col. 2, lines 28-34; col. 8, lines 57-65};

coupling a control unit (18, 18', 54, 66) external to said electronic lock (12, 12', 56, 64). In this case, coupling is in the form of wireless communication;

receiving signals at said electronic lock from said control unit (as shown in figures 1-4); and

controlling said safe in response to said signals {col. 3, lines 23-31}.

In claim 2, the method of claim 1 further comprising a step of sending an unlock signal to said electronic lock from said control unit {paragraph bridging cols. 3 and 4; col. 4, lines 18-29}.

In claim 3, the method of claim 2 wherein said step of sending an unlock signal comprises sending an unlock signal after receiving a lock number (analogous to the claimed user ID) and a PIN {col. 2, lines 34-56}.

In claim 7, the method of claim 1 further comprising a step of sending signals from said electronic lock to said control unit {paragraph bridging cols. 4 and 5}.

Claim 8 recites the combination of claims 1 and 2 and therefore rejected for the same reasons, further comprising the step of:

receiving login information at a control unit external to said safe {col. 2, lines 35-46; col. 3, lines 52-65};

In claim 9, the method of claim 8 further comprising a step of saving said login information in a database {col. 3, lines 23-31}.

In claim 13, the method of claim 8 wherein said step of enabling a user to select an open door option comprises enabling entry of an override response key (46) {col. 6, lines 62-67}.

Claim 14 recites the claim limitations of claim 3 and therefore rejected for the same reasons.

Claims 18-19 recites the limitations of claim 8 and therefore rejected for the same reasons.

Claim 20 recites the limitations of claim 3 and therefore rejected for the same reasons.

Claim 21 recites the limitations of claim 9 and therefore rejected for the same reasons.

Claim 25 recites the combination of claims 6 and 18 and therefore rejected for the same reasons.

In claim 26, the method of claim 18 further comprising a step of providing a status of said electronic lock to said control unit {paragraph bridging cols. 4 and 5}.

Claims 27-34 recites an apparatus used for practicing the method of claims 1-7 and therefore rejected for the same reasons.

12. Claims 1-10, 13-22, and 25-34 are rejected under 35 U.S.C. 102(b) as being anticipated by US 4,914,732 (Henderson et al).

In claims 1, 6 Henderson et al teach of a method of controlling a real estate lockbox (12) (analogous to the claimed safe) {see whole document}, said method comprising the steps of:

providing an electronic lock as shown in figures 1-3 (36, 38) for said lockbox/safe {col. 2, line 50-col. 4, line 29};

coupling a key / control unit (14) external to said electronic lock (12) {col. 5, lines 4-18}. Or coupling a computer / control unit (18) external to said electronic lock (12) {col. 5, lines 4-18}. In this case, coupling is via a stand (16) {paragraph bridging cols. 7 and 8; col. 12, lines 37-56};

receiving signals at said electronic lock from said control unit {col. 9, lines 31-42; lines 53-col. 10, line 27}; and

controlling said lockbox/safe in response to said signals {col. 10, line 53-col. 12, line 10}.

In claims 2 and 10, the method of claim 1 further comprising a step of sending an OPEN/unlock signal to said electronic lock from said control unit {col. 10, lines 53-68}.

In claims 3, 8, 14, 18-20, said step of sending an unlock signal comprises sending an unlock signal after receiving a user ID and a personal identification / PIN {col. 9, lines 31-65; col. 23, lines 6-25}. As shown in figure 13, there are several user ID's used such as listing agent, listing, board or agency ID. And other than personal identification entered by the user, the key (14) has an access code (analogous to the

claimed PIN) {col. 24, lines 10-60}. Further, permission codes (analogous to the claimed PIN) is also used {col. 26, line 52-col. 27, lines 9}

In claims 4 and 15, the method of claim 3 further comprising a step of encrypting said PIN {col. 7, lines 37-54}.

In claims 5, 9, and 16-17, the method of claim 3 further comprising a step of saving at least a portion of said signals in an audit database {col. 3, lines 31-43; col. 15, lines 5-15; paragraph bridging cols. 34 and 35}.

In claim 7, the method of claim 1 further comprising a step of sending signals from said electronic lock to said control unit {col. 28, lines 22-55}.

In claim 13, the method of claim 8 wherein said step of enabling a user to select an open door option comprises enabling entry of an override response key (46) {col. 25, lines 19-46; paragraph bridging cols. 26 and 27}.

Claim 21 recites the limitations of claim 9 and therefore rejected for the same reasons.

Claim 25 recites the combination of claims 6 and 18 and therefore rejected for the same reasons.

In claim 26, the method of claim 18 further comprising a step of providing a status of said electronic lock to said control unit {col. 3, lines 31-43; col. 8, lines 9-14}.

Claim 27 recites an apparatus used for practicing the method of claim 1 and therefore rejected for the same reasons, further comprising:

a receiver/transmitter (14, 42) (analogous to the claimed input/output port) coupled to said electronic lock;

In claim 28, the apparatus of claim 27 wherein said control unit comprises a computer (20).

In claims 29-30, the apparatus of claim 28 wherein said computer comprises a remote computer coupled to said input/output port by way of a communication network (i.e. cellular or paging communication network) {col. 2, lines 28-34}.

In claim 31, the apparatus of claim 29 wherein said remote computer further comprises a database / memory (24).

Claim 34 recites the combination of claims 27 and 31 and therefore rejected for the same reasons.

13. Claims 11-12 and 23-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,654,696 (Henderson et al).

In claim 11, Henderson does not disclose expressly said step of enabling a user to select an open door option comprises providing a predetermined location on said control unit for accessing said electronic lock. However, Henderson teach of a function in the lockbox comprising an SBA that can restrict other agents/users access to a certain listed properties and only the listed agents can have access to the listed property {col. 15, lines 34-46}. And certain agents or agencies can be denied access to a listed property {col. 19, lines 9-37}. Obviously, if a certain agent or agency is allowed access to a listed property, OPEN or SBA is displayed on the control units display screen as discussed above. Obviously, this is an indication to the user that this is a predetermined location that the user can have access to a lockbox. Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art that the OPEN or SBA displayed on the control unit of Henderson is an indication to the user that the lockbox can be accessed in this predetermined location.

In claims 12 and 23, Henderson does not disclose expressly said step of providing a predetermined location comprises providing a secret location on a computer screen. However, a "GOOD" message is displayed whenever any operation is successfully completed {col. 10, lines 1-9}. Obviously, when an operation is unsuccessful, the "GOOD" message will not be displayed. Therefore, when an

operation unsuccessful, a user will not know where the "GOOD" message is displayed and becomes a secret to the user, to one of ordinary skill in the art .

In claim 24, Henderson does not disclose expressly, a step of receiving login information after said secret location is accessed on said computer display. In this case, only when the personal identification entered by the user matches that of the lockbox will the "OPEN" message displayed light up {col. 10, lines 53-61}. Obviously, this is an indication to the user that this is a predetermined location that the user can have access to a lockbox. Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art that the "OPEN" message displayed on the control unit of Henderson is an indication to the user that the lockbox can be accessed in this predetermined location.

14. Claims 4-5, 15-17, and 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,815,557 (Larson) in view of US 5,349,345 (Vanderschel).

In claims 4 and 15, Larson does not disclose the step of encrypting said PIN. However, Vanderschel, in the same field of endeavor (electronic locks), teach of encrypting an access PIN as shown in the table of column 4 {Vanderschel, col. 4, lines 14-41}, for security reasons. Vanderschel suggests that it is desirable to encrypt access PIN's to make it safe from unauthorized inspection {col. 5, lines 21-26}. Clearly, this feature is desirable in the system of Larson. Therefore, at the time of the invention, it

would have been obvious to one of ordinary skill in the art to encrypt the access PIN of Larson, as evidenced by Vanderschel, because this makes it safe from unauthorized inspection.

In claims 5, 16-17, the method of claim 3 further comprising a step of saving at least a portion of said signals in an audit database {col. 3, lines 23-31}.

Claims 32-33 recites an apparatus used in practicing the method of claim 5 and therefore rejected for the same reasons.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 4649723 (Appelbaum), US 4325239 (Larson), and US 3979932 (Piche) are cited because these references teach of lockboxes as a portable safe for small items or key safe {see whole document}.

Examiner Contact Information

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Bangachon whose telephone number is 703-305-2701. The examiner can normally be reached on 4/4/10.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on 703-305-4704. The fax phone numbers for the organization where this application or proceeding is assigned is 703-872-9314 for regular and After Final formal communications. The examiner's fax number is 703-746-6071 for informal communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

William L Bangachon
Examiner
Art Unit 2635

June 15, 2003

Michael Horabik
SPE AU2635
